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09/847,443	05/03/2001	Osamu Ichiyoshi	Q64369	5717

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/847,443

Applicant(s)

ICHIYOSHI, OSAMU

Examiner

Yasin M. Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Response to Amendment**

1. The amendment filed on May 24, 2005 has been fully considered but are not persuasive.
2. Claims 1-4 and 6-14 are presented for examination.

**Response to arguments**

Applicant argues in page 10, second paragraph, that "the specification fully supports the use of a second network. At page 9, line 27 to page 10, line 2, the original specification states "the line between the user terminal 14 and the address server 15 need not be a telephone line, nor a packet line, but may be the Internet for convenience." Since the Internet would be commonly be considered a network by one skilled in the art, applicant submits that the original specification fully supports and enables one skilled in the art to practice the invention as set forth in claims 8 and 9." Examiner respectfully, disagrees applicant's arguments for the following reasons. Fig 3, which shows applicant's invention, does not show two networks as originally presented. Applicant's argues that line (line 30) in fig.3 "may be the Internet for convenience." This line is no different than the line between user 1 and connection point 22

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where server 5 is connected and the line between user 3 and connection point 22 of server 5 (see prior art of fig. 1). These lines as explained in the specification are connections within the telephone network 20. This new interpretation contradicts the specification as explained in (page 8, line 14-27 about the communication network of the current invention of fig. 3.

Specifically, fig. 3 shows communication network 20 defined as PSTN network. The line shown between terminal 14 and the address server 15 is a similar line of the prior art as explained above.

Users communicate within the communication network 20 (a conventional public switched telephone network (PSTN) page 8, lines 20-23 of the specification). In fact applicant argues in his background that the Internet is complex and very costly.

Applicant states four reasons to show the complexity and the disadvantages of using packet network such as the Internet ((page 2, line 14 and page 4, line 24)). Even, if the line

between user 14 and address server 15 is considered an Internet network, Applicant does not explain how data are routed between the subscriber exchange 21 of the PSTN network and connection point 22 of the address server 15. Therefore, this new

interpretation is not enabled in the specification in such a way that one ordinary skill in the art would perform the invention as two networks that are separate and distinct as claimed by the

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applicant in claims 8 and 14. Therefore, Examiner maintains the 112 rejection of claim 8 and 14.

Applicant argues in page 11, second paragraph, "the specification describes a non-limiting embodiment of the invention in which a user stores a home page on a computer with an address that uses a number, e.g. a telephone number or an ISDN number (page 6, lines 22-17). The homepage is registered in a server that performs a function similar to a DNS server of the Internet (page 7, lines 7-10). Since the server may be connected to the Internet (page 9, lines 1-2), a second user can then use a search engine on the Internet to obtain the name of the home page (page 7, lines 11-15). If the search engines returns a home page with an address that has a number, i.e., a telephone number or an ISDN number, the second user can then use his computer to establish communications with the home page of the first user using a telephone network (page 7, lines 16-22). Implicit in this disclosure is simple fact that if the home page has the conventional Internet address, i.e., the Internet protocol will take place in the convention manner. i.e., IP mode.

Examiner notes that in order for IP mode to work the applicant must have two networks, a PSTN network and an Internet network, that are connected with each other. As explained above fig. 3 of

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the Applicant's invention do not show two networks. At best the homepage searched by the user X explains the conventional way of doing things in the normal world of the interne as explained in the prior art of fig. 1 and fig. 2. Applicant's argument/specification that his address server has similar functionality to DNS of the Internet is not clear. The DNS of the Internet is a well-known hierarchical structure the uses TCP/IP protocol. It translates domain names to IP address. Every registered fully qualified domain name corresponds to an IP address in a DNS server. DNS servers maintain records of domain names and their corresponding IP addresses. Therefore, it is easier for a user to search for a homepage that is hosted in a web server that has a unique IP address. Because IP addresses are routable, routers are used to connect computers globally (the Internet). Applicant's address server uses telephone number or ISDN numbers. Applicant did not show how telephone number or an ISDN numbers are routed globally, so that a user accesses a homepage corresponding to a telephone or ISDN number. Applicant did not establish two networks as explained above and the existence of second network as the Internet in fig. 3 is not substantiated, therefore, the IP mode features recited in claim 14 are not enabled.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 8 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (Providing a second network and a server connected to at least the second network). There are no first network and second network as claimed by the applicant according to fig. 3 of the applicant's present invention and corresponding pages of the specification. The only network shown according to fig. 3 of Applicant's present invention is network 20. All terminal and the address server are connected to network 20.

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- Claims 8 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (Providing a second network and a server connected to at least the second network). There are no two networks as claimed by the applicant according to fig. 3 of the applicant's present invention. The only network shown according to fig. 3 of Applicant's present invention is network 20. All terminal and the address server are connected to network 20.
- Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (Wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address,



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then the communication with the terminating side computer is in IP mode).

- Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

(Wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address, then the communication with the terminating side computer is in IP mode).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of

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section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, 7-8, 11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sabatier et al USPN (6754708).

As per claim 1, Sabatier et al teach a computer communication network 1, comprising:

a first computer identified by an address recognizable by a telephone network when the first computer connects to the telephone network (computer 1 is connected to telephone network 4 with its recognizable telephone number (N1, IP1. see abstract);

a second computer identified by an address recognizable by

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the telephone network when the second computer connects to the telephone network (computer 1 is connected to telephone network 4 with its recognizable telephone number (N2, IP2. see abstract);

address server (server 5) for correlatively storing the address defined in the telephone network and a name (N1, N2) corresponding to the address (IP1 and IP 2) [abstract ; col. 2, lines 20-35; col. 3, lines 11-32 and col. 6, lines 50-67], wherein the first computer is configured to request from the address server an address by transmitting a name of the second computer, and is configured to communicate with the second computer using the address received from the address server (abstract and col. 3, lines 11-32 and col. 6, lines 6-67).

As per claim 2, Sabatier et al teach a computer communication network according to claim 1, wherein the addresses recognizable by the telephone network are not Internet protocol addresses [abstract; col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65; col. 6, lines 6-45].

As per claim 3, Sabatier et al teach a computer communication network according to claim 1, the addresses recognizable by the

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telephone network are telephone number [col. 3, lines 21-32 and lines 58-67].

As per claim 4, Sabatier et al teach a computer communication network according to claim 1, wherein the addresses recognizable by the telephone network are numbers in the Integrated Service Digital Network [col. 2, lines 47-57].

As per claim 7, Sabatier et al teach a computer communication network according to claim 1, wherein the address server is an exchanger [server 5, col. 3, lines 7-10].

As per claim 8 and 11, Sabatier et al teach a method and a system for communications on a computer network (fig. 1 and abstract), comprising:

- providing a first network (network 4, fig. 1);

- providing a second network (network 3, fig. 1);

- providing a first computer (terminal 1, fig. 1) identified by a unique address on at least the first network (telephone number as identifier N1);

- providing at least one second computer (terminal 2, fig. 1) identified by a unique address on at least the first network

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(telephone number as identifier N2) providing a server (server 5) on at least the second network (network 3, fig. 1);

communicating with the server from the first computer to initially determine the address of the at least one second computer by communicating on the second network (col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65); and

connecting to the at least one second computer on the first network using the address of the at least one second computer provided by the server (col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65; col. 5, lines 17-28), wherein the first network is a telephone network (STN 4, fig. 1 and col. 2, lines 62-66).

As per claims 14, Sabatier teach computer communication network according to claim 1, wherein if the address returned to the first computer by the address server is a Public Switched Telephone Network (PSTN) number, the communication with the terminating side computer is in PSTN mode (col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65; col. 5, lines 17-28), and wherein if the address returned to the first computer by the address server is an Internet Protocol (IP) address, the

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communication with the terminating side computer is in IP mode  
(col. 6, lines 50 to col.7, line 13).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which  
forms the basis for all obviousness rejections set forth in this  
Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being  
unpatentable over Sabatier et al USPN (6754708 in view of Szutu  
USPUB. (20010047395).

As per claim 6, although Sabatier et al shows substantial  
features of the claimed invention, he does not explicitly show  
where the names in the computer communication network is not  
duplicated.

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Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Sabatier et al, as evidenced by Szutu US PUB. (20010047395).

In analogous art, Szutu whose invention is about a network system for interactively linking a network-independent unique identifier to network resources, discloses domain names in a computer communication network (a network-independent preexisting-unique identifier) that is unique (not duplicate) provided and governed by an Internet-independent administrative authority. Because the names are unique they are not the same as any of the domain name in the Internet [¶ 0010-0011 and ¶ 0017-0018]. Giving the teaching of Szutu, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Sabatier et al by employing the system of Szutu for interactively linking a network-independent unique identifier to network resources. One would be motivated to do so because it provides a unique way of identifying Internet web resources.

5. Claims 9-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatier et al USPN. (6754708) in view of Yablon USPN. (5764731).

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As per claim 9 and 12, Although Sabatier et al shows substantial features of the claimed invention, he does not explicitly show storing the address of the at least one second computer on the first computer so that subsequent connections to the at least second computer do not require communicating with the Server. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Sabatier et al, as evidenced by Yablon USPN. (5764731).

In analogous art, Yablon whose invention is about an enhanced system for transferring, storing and using signaling information in a switched network, discloses storing the address (telephone number) of the at least one second computer (second telephone device) on the first computer (on the memory of first telephone device) so that subsequent connections to the at least second computer do not require communicating with the Server [Col. 12, lines 3-40 and col. 23, lines 1-19]. Giving the teaching of Yablon, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Sabatier et al by employing the system of Yablon. One would be motivated to do so because it provides user a quick way of establishing communications with other user devices absent of server intervention [col. 23, lines 1-19]



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As per claims 10 and 13, Sabatier teach the invention, wherein the connection to the at least second computer on the first network does not use the second network (direct communication through STN 4 could be established between the terminals col. 5, lines 17-23).

### Conclusion

1. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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**KRISNA LIM**  
**PRIMARY EXAMINER**